

nucleotides or both T₃ and T₅ are an oligonucleotide having at least 6 nucleotides.

23 (New) The compound of claim 22 wherein X is C₂₋₂₀ alkyl.

24 (New) The compound of claim 22 wherein X is C₁₋₆ alkyl.

25 (New) The compound of claim 22 wherein X is methyl

REMARKS/ARGUMENTS

After entry of the foregoing amendment, claims 15- 25 will be pending. Support for the additional claims may be found throughout the specification and claims as originally filed. For example, on page 18 line 22, applicants disclose preferred oligonucleotides of at least 12 nucleotides in length. No new matter has been added.

Examiner Owens is thanked for the personal interview conducted with Mr. Herb Boswell on October, 6, 2005. The proposed amendment discussed during the interview has now been embodied in the present amendment. An interview summary was prepared at that time. In reading the summary, it is noted that the two references, Sproat and Miller, were reversed. The present amendment overcomes Miller. Sproat is not prior art as it is dated subsequent to the priority date of the present application. Examiner Owens has been apprised that in a parent application to the present one, Serial No. 07/967,267, the Board of Patent Appeals and Interferences accorded a priority date of August 13, 1990 to that application. The present application, a continuation of the '267 application, enjoys the same priority date. Sproat has a publication date of February 25, 1991 and, accordingly, is not prior art here.

Miller teaches 2' O-methyl guanosine incorporated into a trimer. This species is not contained within the pending claims, each of which requires either a C₂ or greater alkyl chain

DOCKET NO.: ISIS-5246
Application No.: 10/663,155
Office Action Dated: Preliminary Amendment


PATENT

or an oligonucleotide length of C₁₂ or greater. As Miller uses diazomethane in his methods, Miller should be seen to be limited to methyl groups only. Moreover, Millers yields, poor even for synthesis of trimers, are entirely inapplicable to the construction of 12 – mer oligonucleotides. See right hand column of page 1889 where yields of on the order of 7% are shown.

An IDS is also being submitted containing the same reference (Inoue) recently submitted in connection with the parent application, Serial No. 07/967,267. The present claims are clearly distinguishable from Inoue.

The undersigned invites the Examiner to contact him or Mr. Boswell should there be any questions.

Date: October 07, 2005



Joseph Lucci
Registration No. 33,307

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439